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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
RINES, ROBERT D	

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/023,301	LEGNINI, MARK W.	
	Examiner	Art Unit	
	Robert D. Rines	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 December 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *12/20/01*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

[1] This communication is in response to the patent application filed 20 December 2001. The IDS statement filed 20 December 2001 has been entered and considered. Claims 1-20 are pending.

Claim Objections

[2] Claim 20 objected to because of the typographical error "the method according to claim 19 (claim 20, line 1). The examiner assumes the applicant's intention is to direct the claim to the system of claim 19 rather than a method. For purposes of applying art, the examiner will treat the claim accordingly below. However, appropriate correction is recommended.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[3] Claims 1-3 and 17-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnson et al., (United States Patent #6,826,541).

[A] As per claim 1, Johnson et al teaches a method of facilitating a user's selection of a health plan from a plurality of available health plans, said method comprising steps of: a. providing a rating for each of a plurality of attributes for each health plan of the plurality of available health plans (Johnson et al.; col. 5, lines 36-45, col. 9, lines 14-19, and col. 17, lines 42-60); b. determining the relative importance of each of the plurality of attributes to the user (Johnson et al.; col. 10, lines 3-10 and col. 10, lines 30-56); and c. computing a score for each health plan of the plurality of available health plans based on the relative importance of each of the plurality of attributes to the user in comparison to the rating for each of the plurality of attributes of each

health plan of the plurality of available health plans (Johnson et al.; col. 11, lines 37-61 and Fig. 3), said score being computed according to scoring rules (Johnson et al.; col. 11, lines 37-61 and col. 13, lines 44-67).

[B] As per claim 2, Johnson et al teaches a method wherein the rating for each of a plurality of attributes for each health plan of the plurality of available health plans is a rating from the group consisting of: a. an above average rating, b. an average rating, and c. a below average rating (Johnson et al.; col. 2, lines 35-41, col. 3, lines 39-46)

NOTE: While Johnson et al., does not use the specific terminology employed by the applicant, Johnson et al., requires users to: 1) select plan attributes that are of any importance at all to the user (Johnson et al.; col. 2, lines 35-37 and col. 10, lines 3-15) and 2) rate the importance of each attribute on a scale of 1-5 (Johnson et al.; col. 3, lines 39-46 and col. 10, lines 30-40). The examiner interprets the 1-5 scoring system of Johnson et al., as encompassing the applicant's limitations of "below average, average, and above average" (i.e., below average=1, average=3, and above average=5).

[C] As per claim 3, Johnson et al., teaches a method wherein the relative importance of each of the plurality of attributes to the user is a measure of relative importance from the group consisting of: a. an above average importance, b. an average importance, and c. a below average importance (Johnson et al.; col. 2, lines 32-59 and col. 10, lines 30-59).

NOTE: While Johnson et al., does not use the specific terminology employed by the applicant, Johnson et al. scores the relative importance of each plan attribute on a scale of -4 to +4 (Johnson et al.; col. 13, lines 1-43). Further, the Johnson et al., is "not limited to any particular scale for rating user preferences" (Johnson et al.; col. 13, lines 44-46). The examiner interprets the teachings of Johnson et al., to produce scores associated with each plan attribute that equate to the applicant's limitations of "above average, average, and below average", i.e., attributes are assigned scores, represented in numerical figures (-4 to +4) that equate to above average, average, and below average ratings.

[D] As per claim 17, Johnson et al. teaches a computer implemented system for facilitating a user's selection of a health plan from a plurality of available health plans, said system comprising: a. a database including a rating for each of a plurality of attributes for each health plan of the plurality of available health plans (Johnson et al.; col. 7, lines 1-14 and col. 10, lines 3-29) b. means for determining the relative importance of each of the plurality of attributes to the user (Johnson et al.; col. 10, lines 3-57); and c. means for computing a score for each health plan of the plurality of available health plans based on the relative importance of each of the plurality of attributes to the user in comparison to the rating for each of the plurality of attributes of each health plan of the plurality of available health plans, said score being computed according to scoring rules (Johnson et al.; col. 11, lines 37-61 and Fig. 3).

[E] As per claim 18, Johnson et al. teaches a system wherein the rating for each of a plurality of attributes for each health plan of the plurality of available health plans is a rating from the

group consisting of: a. an above average rating, b. an average rating, and c. a below average rating (Johnson et al.; col. 2, lines 33-59, col. 7, lines 1-14, col. 11, lines 56-61 and Fig. 5 *see analysis claim 2).

[F] As per claim 19, Johnson et al. teaches a system wherein the relative importance of each of the plurality of attributes to the user is a measure of relative importance from the group consisting of: a. an above average importance, b. an average importance, and c. a below average importance (Johnson et al.; col. 2, lines 32-59, col. 7, lines 1-14, and col. 10, lines 30-59 *see analysis claim 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

[4] Claims 4-10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al.

[A] As per claim 4, Johnson et al. teaches a method wherein the scoring rules include: a. assigning each health plan a starting score (Johnson et al.; col. 17, lines 23-60), b. for each attribute having a below average relative importance, maintaining the score of each health plan for the attribute (Johnson et al.; col. 17, lines 1-60), c. for each attribute having an average relative importance, i. increasing by a first determined amount the score of each health plan having a rating of above average for the attribute (Johnson et al.; col. 13, lines 44-62 and col. 17, lines 24-60), ii. maintaining the score of each health plan having a rating of average for the attribute (Johnson et al.; col. 13, lines 44-62 and col. 17, lines 24-60), and iii. decreasing by a second determined amount the score of each health plan having a rating of below average for the attribute (Johnson et al.; col. 13, lines 44-62 and col. 17, lines 24-60); and d. for each attribute having an above average relative importance, i. maintaining the score of each health plan having a rating of above average for the attribute (Johnson et al.; col. 13, lines 44-62 and col. 17, lines 24-60), ii. decreasing by a third determined amount the score of each health plan having a rating of average for the attribute (Johnson et al.; col. 13, lines 44-62 and col. 17, lines 24-60), and iii. decreasing by a fourth determined amount the score of each health plan having a rating of below average for the attribute (Johnson et al.; col. 13, lines 44-62 and col. 17, lines 24-60).

[i] Johnson et al., does not specifically disclose a starting score, the Johnson method uses summed "computed importance" values to arrive at the cumulative "total utility score" for each plan (Johnson et al.; col. 17, lines 42-51). Accordingly, the examiner's interpretation of Johnson's teachings are that each plan is, indirectly, assigned an initial score of zero prior to user selection of required or optimal attributes and user assessment of importance of plan attributes. Johnson et

al. further teaches that the Johnson et al., invention is not limited to using any particular scale for rating user preferences (Johnson et al.; col. 13, lines 44-48). As noted above, Johnson et al., awards points or scoring values to a plan having attributes that are identified as important to the user, accordingly, each plan is differentiated by the cumulative score with the best fit plan attaining the highest positive score (Johnson et al.; col. 17, lines 43-60). Where Johnson et al. appears to differ from the instant application is that Johnson et al. does not decrease the overall score or detract points awarded to a plan lacking in a given attribute but rather awards fewer or zero points to the plan. However, the examiner is interpreting the above noted teachings of Johnson et al., particularly with regard to flexibility in scale, to indicate that all that would be required to change the Johnson invention to meet the requirements/limitations defined by the present application would be to pick a mid-range positive starting score for each plan, as opposed to starting each plan at 0. Accordingly, the examiner views the teachings of Johnson et al. as encompassing the applicant's limitations of increasing or decreasing the plan score depending on strengths and weakness of each plan with respect to weighted or important attributes.

[ii] It would have been obvious to one of ordinary skill in the art at the time the invention was made that the Johnson et al., invention is not limited to using any particular scale for rating user preferences (Johnson et al.; col. 13, lines 44-46), and accordingly, Johnson's rating system/method could have been modified to accommodate a user design choice such as establishing the initial starting scores of each of the available health plans at a mid-range positive score rather than starting each score at zero, as is taught in Johnson's exemplary embodiment.

[B] As per claim 5, Johnson et al. teaches a wherein the first determined amount equals the second determined amount (Johnson et al.; col. 13, lines 44-62 and col. 17, lines 24-60), and the second determined amount equals the third determined amount (Johnson et al.; col. 13, lines 44-62 and col. 17, lines 24-60), and the third determined amount is less than the fourth determined amount (Johnson et al.; col. 13, lines 44-62 and col. 17, lines 24-60).

[C] As per claim 6, Johnson et al. teaches a method further including a step of sorting the plurality of available health plans according to the score computed for each of the plurality of available health plans (Johnson et al.; col. 11, lines 56-61).

[D] As per claim 7, Johnson et al. teaches a method further including a step of calculating estimated total co-payment amounts for a determined period of time for at least two health plans from the plurality of available health plans (Johnson et al.; col. 10, lines 3-29 and col. 24, lines 26-47 and Fig. 4).

[E] As per claim 8, Johnson et al. teaches a method wherein the step of calculating estimated total co-payment amounts further includes a step of requesting the user to provide estimates of a number of doctor visits, a number of hospital visits and a number of prescriptions filled (Johnson et al.; col. 10, lines 15-29 and col. 12, lines 10-25 and Fig. 4).

[F] As per claim 9, Johnson et al. teaches a method further including a step of displaying the rating for each of the plurality of attributes for at least two health plans from the plurality of

available health plans (Johnson et al.; col. 11, lines 56-61).

[G] As per claim 10, Johnson et al. teaches a method further including a step of providing online enrollment for a plan from the plurality of available health plans (Johnson et al.; col. 8, lines 6-19 and col. 24, lines 42-49).

[H] As per claim 20, Johnson et al. teaches a method (system - see claim objections above) wherein the scoring rules include: a. assigning each health plan a starting score (Johnson et al.; col. 17, lines 23-60), b. for each attribute having a below average relative importance, maintaining the score of each health plan for the attribute (Johnson et al.; col. 17, lines 1-60), c. for each attribute having an average relative importance i. increasing by a first determined amount the score of each health plan having a rating of above average for the attribute (Johnson et al.; col. 13, lines 44-62 and col. 17, lines 24-60), ii. maintaining the score of each health plan having a rating of average for the attribute (Johnson et al.; col. 13, lines 44-62 and col. 17, lines 24-60), and iii. decreasing by a second determined amount the score of each health plan having a rating of below average for the attribute (Johnson et al.; col. 13, lines 44-62 and col. 17, lines 24-60); and d. for each attribute having an above average relative importance, i. maintaining the score of each health plan having a rating of above average for the attribute (Johnson et al.; col. 13, lines 44-62 and col. 17, lines 24-60), ii. decreasing by a third determined amount the score of each health plan having a rating of average for the attribute (Johnson et al.; col. 13, lines 44-62 and col. 17, lines 24-60), and iii. decreasing by a fourth determined amount the score of each

health plan having a rating of below average for the attribute (Johnson et al.; col. 13, lines 44-62 and col. 17, lines 24-60 *see analysis claim 4).

[i] Regarding claims 5-10 and 20, the obviousness as discussed with regard to claim 4 above is applicable to claims 5-10 and 20 and are herein incorporated by reference.

[5] Claims 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. in view of Wizig (United States Patent #6,735,569).

[A] As per claim 11, the teachings of Johnson et al. are directed to assisting a user in making an optimal selection of a variety of products and services from a number of potential options (Johnson et al.; Abstract and col. 2, lines 32-59). Specifically, Johnson et al. teaches a. providing a rating for each of a plurality of attributes for each service/product of the plurality of available service/product (Johnson et al.; col. 5, lines 36-45, col. 9, lines 14-19, and col. 17, lines 42-60); b. determining the relative importance of each of the plurality of attributes to the user (Johsnon et al.; col. 10, lines 3-10 and lines 30-56); and c. computing a score for each service/product of the plurality of available services/products based on the relative importance of each of the plurality of attributes to the user in comparison to the rating for each of the plurality of attributes of each service/product of the plurality of available services/products (Johnson et al.; col. 11, lines 37-61 and Fig. 3), said score being computed according to scoring rules (Johnson et al.; col. 11, lines 37-61 and col. 13, lines 44-67).

[i] Although Johnson et al., teaches that the Johnson invention is designed to assist consumers in making decisions regarding a number of product/services (Johnson et al.; col. 5, lines 59-62), the exemplary embodiment taught by Johnson et al. is directed to the selection of health plans by consumers (Johnson et al.; col. 5, lines 37-39). Johnson et al. fails to specifically teach applying the invention to consumer selection of a health care provider.

[ii] However, Wizig teaches a method for facilitating a user's selection of a health care provider from a plurality of available health care providers (Wizig; col. 13, lines 42-65).

[iii] It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Johnson et al. with those of Wizig. Such combination would have resulted in a system/method that requires a user to go through a series of choices to assist the user in identifying attributes of products/services that are of importance to the user, and further, to assist the user in quantifying the relative importance of a number of product/service attributes to determine the product/service package that best suits the user (Johnson et al.; col. 2, lines 32-59). Such a system/method would have been suitable for assisting consumers in choosing health plans but would have been developed to be generic/flexible enough to be applied to any complex decision (Johnson et al.; col. 5, lines 59-62). For example, such a system/method would have been capable of assisting a user in the selection of a health care provider by searching databases available on other systems such as a physician background database and a referral database, and according to relevant criteria such as the physician's distance from the user, value, price or hospital affiliation (Wizig; col. 13, lines 55-65). The

motivation to combine the teachings would have been to empower individuals as consumers in contracting for the healthcare services that they need, from the healthcare providers they prefer, and at a price that is within their financial restraints (Wizig; col. 2, lines 45-59).

[B] Claims 12-16 differ from method claims 2-6 in that claims 2-6 are directed to assisting a user in the selection of a health plan while claims 12-16 are directed to assisting a user in the selection of a health care provider. As per this element, Wizig teaches a system/method that enables a user to select the health care provider they prefer by analyzing criteria such as the physician's distance from the user, value, price or hospital affiliation (Wizig; col. 13, lines 55-65).

[i] The remainder of claims 12-16 repeat the same limitations of method claims 2-6, and are therefore rejected in view of Johnson et al. for the same reasons given for those claims.

[ii] Further, regarding claims 12-16, the obviousness and motivation to combine as discussed with regard to claim 11 above are applicable to claims 12-16 and are herein incorporated by reference.

Conclusion

[6] The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Debruin-Ashton, PERSONALIZED HEALTH CARE PROVIDER DIRECTORY, United States Patent #6,014,629

Henley, METHOD AND SYSTEM FOR PROVISION AND ACQUISITION OF MEDICAL SERVICES AND PRODUCTS, United States Patent Application Publication #2002/0065758

Bianco et al., ELECTRONIC PATIENT HEALTHCARE SYSTEM AND METHOD, United States Patent Application Publication #2002/0082865

Bonin et al., SYSTEM AND METHOD FOR SELECTION OF A PRIMARY CARE PHYSICIAN, United States Patent Application Publication #2002/0116223

Chishti et al., METHOD AND SYSTEM FOR DISTRIBUTING PATIENT REFERRALS, United States Patent Application Publication #2002/0133386.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert D. Rines whose telephone number is 571-272-5585. The examiner can normally be reached on 8:30am - 5:00pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RDR

8/27/06

C. LUKE GILLIGAN
PATENT EXAMINER